

Application Serial No. 09/843,073
Amendment dated August 5, 2004
Reply to Office action of May 5, 2004

REMARKS

Claims 1 through 6 and 8 through 13 are pending in this application. Claims 1, 4, 10, and 13 are amended herein. Support for the amendments to claims 1, 4, 10, and 13 may be found in the claims as filed originally. It is submitted that claims 1, 4, 10, and 13 were allowable in the absence of the amendments. Claims 1, 4, 10, and 13 are amended strictly in the interest of compact prosecution, and not for any reason of patentability. Reconsideration of the application is requested based on the foregoing amendment and the following remarks.

Claim Rejections - 35 U.S.C. § 103:

Claims 1 through 6 and 8 through 13 were rejected under 35 U.S.C. § 103(a) as unpatentable over Kimura, US 6,322,875, in view of Kenmochi, US 6,084,190. The rejection is traversed. Reconsideration of the rejection is respectfully requested.

Claim 1 recites, in pertinent part,

"a printed layer over the undercoat layer."

Kimura neither teaches, discloses, nor suggests a printed layer over the undercoat layer, as recited in claim 1. In Kimura, rather, the inorganic thin-film layer 5 is between the protecting layer 6 and the printed layer 2, as shown in Fig. 2. Kenmochi does not either, and thus cannot make up for the deficiencies of Kimura with respect to claim 1.

In Kenmochi, rather, film 6 formed with printed pattern layer 4 is heat fused on the surface of key top 2, as described at column 5, lines 49 and 50. Thus, neither Kimura nor Kenmochi teach, disclose, or suggest a printed layer over the undercoat layer, as recited in claim 1. Since neither Kimura nor Kenmochi teach, disclose, or suggest a printed layer over the undercoat layer, their combination cannot, either. Claim 1 is thus submitted to be allowable.

Claim 1 recites further,

"a molded film which is formed over the surface of said undercoat layer so as to cover said undercoat layer and which allows transmission of the metallic color of said undercoat layer."

Kimura neither teaches, discloses, nor suggests a molded film, as acknowledged graciously in the final Office action. The final Office action proposes to remedy this deficiency of Kimura by combining it with Kenmochi, asserting that "(t)he film on the key top is formed by resin molding." This is submitted to be incorrect.

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In Kenmochi, rather, key top 2 *itself* is formed by resin molding, not film 6 on the key top, as described at column 5, lines 48 and 49. Thus, neither Kimura nor Kenmochi teach, disclose, or suggest a molded film which is formed over the surface of an undercoat layer so as to cover the undercoat layer and which allows transmission of a metallic color of the undercoat layer, as recited in claim 1.

Since neither Kimura nor Kenmochi teach, disclose, or suggest a molded film which is formed over the surface of an undercoat layer so as to cover the undercoat layer and which allows transmission of a metallic color of the undercoat layer, their combination cannot, either. Claim 1 is thus submitted to be allowable.

Claim 1 recites further,

"wherein said protective film substantially prevents heat from being conveyed from said base body to said undercoat layer."

Neither Kimura nor Kenmochi teach, disclose, or suggest a protective film that substantially prevents heat from being conveyed from a base body to an undercoat layer. Since neither Kimura nor Kenmochi teach, disclose, or suggest a protective film that substantially prevents heat from being conveyed from a base body to an undercoat layer, their combination cannot, either.

Furthermore, modifying a reference so as to render it unsuitable for its intended purpose is prohibited by M.P.E.P. §2143.02. An intended purpose of Kimura is to provide a "decoration key top having a fine and high grade aspect" as described at column 1, lines 5 and 6. Kenmochi discloses forming a key top by resin molding at column 2, line 3. If the resin molding process of Kenmochi were used to form Kimura's key top, the heat attributed to resin molding would impair aesthetically Kimura's inorganic thin membrane 5, and Kimura would no longer provide a decoration key top having a fine and high grade aspect. The modification proposed in the final Office action would thus render Kimura unsuitable for its intended purpose, in contravention of M.P.E.P. §2143.02. The undercoat layer recited in claim 1, on the other hand, will be substantially protected from heat being conveyed from the base body by the protective film. Thus the undercoat layer's metallic color will not be impaired by heat attributed to the resin molding process. Claim 1 is thus submitted to be allowable. Withdrawal of the rejection of claim 1 is earnestly solicited.

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Claims 2, 5, 6, 8, and 9 depend from claim 1 and add further distinguishing elements.

Claims 2 through 6, 8, and 9 are thus also submitted to be allowable. Withdrawal of the rejection of claims 2 through 6, 8, and 9 is earnestly solicited.

Claim 10 recites, in pertinent part,

"applying a printed layer to said molded film;
applying an undercoat layer to said printed layer."

It is submitted respectfully that neither Kimura nor Kenmochi teach, disclose, or suggest applying a printed layer to a molded film and applying an undercoat layer to the printed layer, for the reasons discussed above with respect to claim 1. Since neither Kimura nor Kenmochi teach, disclose, or suggest applying a printed layer to a molded film and applying an undercoat layer to the printed layer, their combination cannot, either. Claim 10 is thus submitted to be allowable.

Claim 10 recites further,

"molding a molded film in a button shape."

It is submitted respectfully that neither Kimura nor Kenmochi teach, disclose, or suggest molding a molded film in a button shape. Neither Kimura nor Kenmochi, in fact, show any molded film at all, as discussed above with respect to claim 1. Since neither Kimura nor Kenmochi teach, disclose, or suggest molding a molded film in a button shape, their combination cannot, either. Claim 10 is thus submitted to be allowable.

Claim 10 recites further,

"preventing heat from being conveyed substantially from said base body to said undercoat layer with said protective film."

Neither Kimura nor Kenmochi teach, disclose, or suggest a protective film that substantially prevents heat from being conveyed from a base body to an undercoat layer, as discussed above with respect to claim 1. Since neither Kimura nor Kenmochi teach, disclose, or suggest a protective film that substantially prevents heat from being conveyed from a base body to an undercoat layer, their combination cannot, either. Claim 10 is thus submitted to be allowable. Withdrawal of the rejection of claim 10 is earnestly solicited.

Claims 11 and 12 depend from claim 10 and add further distinguishing elements.

Claims 11 and 12 are thus also submitted to be allowable. Withdrawal of the rejection of claims

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11 and 12 is earnestly solicited.

Claim 13 recites, in pertinent part,

"a layered film having a transparent film, a printed layer, and an undercoat layer formed of metal deposited on a back surface of said printed layer by vapor deposition."

Neither Kimura nor Kenmochi teach, disclose, or suggest a layered film having a transparent film, a printed layer, and an undercoat layer formed of metal deposited on a back surface of the printed layer, for the reasons discussed above with respect to claim 1. Since neither Kimura nor Kenmochi teach, disclose, or suggest a layered film having a transparent film, a printed layer, and an undercoat layer formed of metal deposited on a back surface of the printed layer, their combination cannot, either. Claim 13 is thus submitted to be allowable.

Claim 13 recites further,

"said layered film is molded so that a back surface of said protective film covers said base body of said button."

Neither Kimura nor Kenmochi teach, disclose, or suggest a molded film, as discussed above with respect to claim 1. Since neither Kimura nor Kenmochi teach, disclose, or suggest a molded film, their combination cannot, either. Claim 13 is thus submitted to be allowable.

Claim 13 recites further,

"a protective film formed between said base body and said undercoat layer in order to prevent heat from being conveyed from said base body to said undercoat layer."

Neither Kimura nor Kenmochi teach, disclose, or suggest a protective film that substantially prevents heat from being conveyed from a base body to an undercoat layer, as discussed above with respect to claim 1. Since neither Kimura nor Kenmochi teach, disclose, or suggest a protective film that substantially prevents heat from being conveyed from a base body to an undercoat layer, their combination cannot, either. Claim 13 is thus submitted to be allowable. Withdrawal of the rejection of claim 13 is earnestly solicited.

Response to Arguments:

The Office action asserts that it is well known that a polymer may be molded. Even if that is true, there is still no evidence to suggest that a polymer be molded *in combination with the other elements of the claims*. Many, many processes are known individually to those of skill in the art. Since a claim is a combination of elements, a prima facie case of obviousness

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requires a showing that persons of ordinary skill in the art at the time the invention was made would have combined the elements in the manner proposed by the Office action, not simply that the elements may or may not have been known individually.

Furthermore, whether the Applicants discuss molding in their own disclosure in connection with an embodiment of their invention should be of no relevance to the general level of skill in the art at the time the invention was made. If the Applicants own disclosure is going to be held against them, how will anyone ever get a patent?

Furthermore, if the Office action seeks to modify Kimura in view of Kenmochi, the Office action needs to produce some evidence that persons of ordinary skill in the art at the time the invention was made would have seen fit to modify Kimura in view of Kenmochi. Describing Kenmochi as being introduced simply to introduce the use of moldable materials in keys/buttons does not relieve the Office action of the responsibility to produce evidence that persons of ordinary skill in the art at the time the invention was made would have seen fit to modify Kimura in view of Kenmochi.

Finally, the Applicants disagree that it is an inherent characteristic of ANY type of layer of membrane to prevent heat, as asserted in the Office action. To the contrary, there are types of layers and membranes that actually conduct heat, let alone fail to prevent it.

Conclusion:

Accordingly, in view of the reasons given above, it is submitted that all claims 1 through 6 and 8 through 13 are allowable over the cited references. Allowance of all claims 1 through 6 and 8 through 13 and of this entire application are therefore respectfully requested.

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Respectfully submitted,

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